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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,101	08/04/2003	Junichi Kurihara	450100-04706	5863

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William S. Frommer, Esq.  
FROMMER LAWRENCE & HAUG LLP  
745 Fifth Avenue  
New York, NY 10151

EXAMINER
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SWEARINGEN, JEFFREY R

ART UNIT	PAPER NUMBER
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2145

MAIL DATE	DELIVERY MODE
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09/02/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/634,101

**Applicant(s)**

KURIHARA, JUNICHI

**Examiner**

JEFFREY R. SWEARINGEN

**Art Unit**

2145

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 14 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed 7/14/2008 have been fully considered but they are not persuasive.
2. Applicant argued that the combination of Rangan and Gupta failed to disclose that the corresponding user is charged a usage fee proportional to the user area size allocated to the corresponding user. Gupta taught an internet advertising system. Applicant admits there is no content provider in claim 1. Someone must inherently pay for the content in Applicant's system, and if there is no content provider, then the fee must fall upon the corresponding user. Furthermore, even assuming *arguendo* that Applicant's assertions about the content provider in Gupta are correct, Gupta further discloses in column 9, lines 10-32 a tracking system to monitor a user's credit history, earnings, interests, purchases, the sites the user has accessed, etc. It would still have been obvious to one of ordinary skill that given the amount of information that Gupta stores about a user profile, that the stored information could be used in a billing scheme where the user receiving the content would be charged for use of the content. See further column 10, lines 6-8 of Gupta disclosing a payment-based terminal which a user uses to access content.
3. Applicant argued that the combination of Rangan and Gupta failed to disclose the content files are not downloadable for permanent storage by the corresponding user. Applicant admits the content in Rangan is streamed. Streamed content is not "permanently stored", rather, streamed content as known to one of ordinary skill is temporarily buffered during playback and then destroyed or cached. One of ordinary skill recognized that the temporary access taught by Rangan (see further column 9, lines 1-15) is not permanent storage on the client end. Rangan further supports this in column 9, lines 44-47, which allows for video streaming on demand from a server. A video streamed on demand from a server is not stored by the client, since it can be accessed at any time on the server. Rangan further supports prevention of the recording of video by the recipient. See column 14, lines 8-11, where a user can only record video based upon allowance of security privileges.
4. Applicant argued that the combination of Rangan and Gupta failed to disclose superposing personal information, by the content provider, including a user-identification that identifies the

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corresponding user on the streaming content. Applicant misreads the Office Action. The technology exists to add any sort of data onto streaming data. Because this ability exists in the combination of Rangan and Gupta, ANY data may be chosen to be superposed upon the streaming data. Therefore it would have been obvious to add a date, a file name, a recitation of the alphabet in the language of choosing of one of ordinary skill, or even user identification, to the streamed data.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rangan et al. (US 6,154,771) in view of Gupta et al. (US 6,487,538).

7. In regard to claim 1, Rangan disclosed:

*content file storing means for storing files of said contents; column 11, lines 53-63*

*user-oriented content storing means in which a user area of a predetermined size is allocated to each of said users for the storage of a content owned by a corresponding one of the users; column 11, lines 55-63*

*file managing means for managing the content files stored in said content file storing means and the contents stored in the user areas of said user-oriented content storing means, wherein the file managing means copies content files selected by the user from the content file storing means to the corresponding user area; and column 23, lines 57-60*

*content delivering means for providing said corresponding user with said contents stored in said corresponding user area, the contents provided to the corresponding user solely as streaming content wherein the content files are not downloadable for permanent storage by the corresponding user, column 23, line 64 – column 24, line 5*

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*wherein each of said corresponding users is charged a usage fee proportional to the user area size allocated to the corresponding user in said user-oriented content storing means.*

Column 21, line 35 teaches the transmission of commercials.

Rangan failed to disclose advertisers who use commercials are charged fees. Rangan further failed to disclose that such fee is a usage fee proportional to the user area size allocated to the corresponding user.

Gupta disclosed an internet advertising system. Web hosts sell advertising space.

Gupta, column 1, lines 24-25. Advertising sizes must be known before insertion of an advertisement. Gupta, column 12, lines 23-41. The price may be dependent on the advertisement size. Gupta, column 12, lines 42-50.

In order for Rangan to make the most money off of premium advertisers who buy larger ads, it would have been obvious to one of ordinary skill in the art at the time of invention to incorporate Gupta's advertising cost basis methods into Rangan to allow for commercial success.

8. In regard to claim 2, Rangan further disclosed:

*said content files are moving picture files.* Column 21, lines 22-26

9. In regard to claim 3, Rangan further disclosed:

*said content management unit further comprises picture processing means for carrying out picture processing to superpose personal information about the corresponding user on a streaming screen of the content being delivered to the corresponding user.* Column 21, lines 58-67. The transmission of inserted information such as interactive commercials, dynamic hyperlinks, security information, text captions and other control information are "personal information about the corresponding user".

10. In regard to claim 4, Rangan further disclosed:

*a copied content file is stored into said user area of the corresponding user as the content owned by the corresponding user.* Column 21, lines 22-26

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11. In regard to claim 5, Rangan further disclosed:

*a link file linked to a content file is stored into said user area of the corresponding user in lieu of the content owned by the corresponding user.* Column 22, lines 30-40

12. Claim 6 is substantially the same as claim 1.  
13. Claim 7 is substantially the same as claims 2-3.  
14. Claim 8 is substantially the same as claims 1 and 3.  
15. In regard to claim 9, Rangan further disclosed:

*the personal information includes a corresponding user identification.* Column 21, lines 58-67. The transmission of inserted information such as interactive commercials, dynamic hyperlinks, security information, text captions and other control information are "a user identification".

16. In regard to claim 10, Rangan further disclosed inserting customized text captions over video being streamed to users. Rangan further stated security information and other control information could be inserted in video. See Rangan, column 21, lines 58-61. It would have been obvious to one of ordinary skill in the art that since security and control information could be inserted, that any text information could be inserted into the video of Rangan.

### **Conclusion**

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
- |                   |              |
|-------------------|--------------|
| 18. Philyaw       | US 6,845,388 |
| 19. Mathai et al. | US 6,847,969 |
| 20. Dean et al.   | US 7,249,059 |
| 21. Philyaw       | US 7,379,901 |
22. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey R. Swearingen whose telephone number is (571)272-3921. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on 571-272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jeffrey R. Swearingen  
Examiner  
Art Unit 2145

/J. R. S./  
Examiner, Art Unit 2145

/Jason D Cardone/  
Supervisory Patent Examiner, Art Unit 2145